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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,240	10/14/2003	Leroy Braun	M33.12-0024	5742

164 7590 05/09/2005

KINNEY & LANGE, P.A.
THE KINNEY & LANGE BUILDING
312 SOUTH THIRD STREET
MINNEAPOLIS, MN 55415-1002

EXAMINER	
CHAPMAN JR, JOHN E	
ART UNIT	**PAPER NUMBER**
2856	

DATE MAILED: 05/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/685,240	BRAUN ET AL.	
	Examiner	Art Unit	
	John E. Chapman	2856	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 March 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *3/16/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on March 16, 2005 has been entered.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1, 2, 4, 5, 12 and 13 are rejected under 35 U.S.C. 102(a) as being anticipated by Japanese Patent Publication JP 07-308310 (the '310 publication).

Regarding claim 1, the '310 publication discloses a method of obtaining hearing ability related data from a subject comprising outputting test tones from a test signal generator 4, monitoring the subjects responses to the tones, detecting when an error has occurred in the test

subject's input and selecting a message to display on display 26. The message may say either "Patient is responding to masking noise" or "Patient response button has been pressed" (see paragraphs 42 and 64), and may comprise an instruction to stop the response (see paragraph 84).

Regarding claim 2, the steps are performed according to a logical testing procedure.

Regarding claim 4, the '310 publication teaches using voice to notifying the patient of the detected error (see paragraph 85).

Regarding claim 12, the computer 3 comprises an input/output interface S2H, SI, S2I, S13.

5. Claims 3 and 14 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 07-308310.

Regarding claim 3, the only difference, if any, between the claimed invention and the prior art consists in the logical testing procedure. The '310 publication teaches the use of a standard pure sound examination method (see paragraph 22). It is not clear whether the disclosed method comprises the Hughson-Westlake procedure. Nevertheless, the Hughson-Westlake procedure is a standard pure sound examination method and if the disclosed method is not the Hughson-Westlake procedure, it would have been obvious to one of ordinary skill in the art to substitute one pure sound examination method for another.

Regarding claim 14, the results of the audiometric test are stored in a storage memory for later retrieval (see paragraph 26). The only difference, if any, between the claimed invention and the prior art consists in displaying the results on the display 26. If the '310 publication does not teach displaying the test results on the display 26, it would have been obvious to one of ordinary

skill in the art to retrieve the test results stored in the computer 3 and display it on the display 26 attached to the computer.

6. Claims 6-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 07-308310.

Regarding claim 6, the only difference between the claimed invention and the prior art consists in operatively coupling microprocessor circuitry to the CPU 3 of the '310 publication. The CPU 3 provides instructions to the display 26, an audio circuitry 4 is operatively connected to the CPU for generating audible test tones, and an interface SI3 is operatively connected to the CPU for signaling whether a test subject perceives the audible test tones. Hence, all the recited functions (generating audible test tones, monitoring responses by the test subject, detecting errors in the responses, and selectively producing instructions responsive to the detected errors) are performed by the CPU 3. It is not clear that the microprocessor circuitry recited in the claim performs any function. Since it is not clear that the microprocessor circuitry performs any function, the microprocessor circuitry may be operatively coupled to the CPU 3 for any reason. It would have been obvious to operatively connect a video card to the CPU 3 in order to drive the display 26, which video card typically comprise microprocessor circuitry including a memory. In addition, the '310 publication teaches storing the results of the audiometric test in a storage memory but does not illustrate a storage memory (see paragraph 26). It is well known in the art to store data in the memory of a microprocessor circuitry, and merely to store the audiometric test results of the '310 publication in the memory of a microprocessor circuitry would have been obvious to one having ordinary skill in the art.

Regarding claim 9, note the remarks regarding the Hughson-Westlake procedure in Paragraph 5 above.

Regarding claim 11, it would have been obvious to operatively connect a host computer comprising a microprocessor to the CPU 3 in order to control a number of similar CPU's and thereby simultaneously test a plurality of test subjects.

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1, 2, 4 and 12-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,416,482. Although the conflicting claims are not identical, they are not patentably distinct from each other because "resuming" in claim 1 implies switching between outputting tones and delivering corrective instructions. The "corrective instruction" in claim 1 comprises the "sound representative of the sound signals" that is selected in response to the "test error" in claim 2 of '482. Regarding claims 12-14, it would have been obvious to provide a computer to effect the method for automatedly administering an audiometric test of claim 2 of '482.

9. Claims 1, 2, 4 and 12-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 5,811,681. Although the conflicting claims are not identical, they are not patentably distinct from each other because "resuming" in claim 1 implies switching between outputting tones and delivering corrective instructions. The "corrective instruction" in claim 1 comprises the "test instruction" that is selected in response to the "test error" in claim 3 of '681. Regarding claims 12-14, a computer is recited in the method for administering an audiometric test of claim 3 of '681.

10. Claims 1-5 and 12-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 11/053,480. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-5 comprise an obvious rewording of claims 1-5, 6-10 and 12-16 of '480, and displaying or printing would have been obvious. Claims 12-14 are directed to an obvious means for performing the claimed method.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claims 1-5 and 12-14 of this application conflict with claims 1-17 of Application No. 11/053,408. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in

more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John E. Chapman whose telephone number is (571) 272-2191. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron Williams can be reached on (571) 272-2208. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

John E Chapman
Primary Examiner
Art Unit 2856